

REQUEST FOR RECONSIDERATION  
U.S. APPLN. NO. 10/028,914

**REMARKS**

The claims under consideration are claims 1-9, 17 and 18.

The present application was filed as a divisional application of parent U.S. Serial No. 09/417,144, now U.S. Patent 6,372,339.

As background information, in the parent application, in the Office Action dated July 10, 2001, the Examiner set forth a plurality of patentably distinct species comprising:

Species A comprising the hydrophilic polymer of claims 4-7.

Species B comprising inorganic fine particles of claims 10-16, 19 and 20.

Species B was prosecuted in the parent application as species A forms the subject matter of this divisional application. Species claims 4-7 were withdrawn from consideration in the parent under 37 C.F.R. § 1.142 (b) as being drawn to a non-elected invention.

In paragraph 2 of the Office Action, on page 2, the Examiner rejects claims 1-9 17, and 18 under the first paragraph of 35 U.S.C. § 112 as based on a non-enabling disclosure. The Examiner submits that inorganic fine particles are critical or essential to the practice of the invention but not included in the claims. The Examiner particularly refers to a portion of the application at pages 3-4 thereof.

In the Office Action, the Examiner is referring to the use of the conjunctive "and" in the last line on page 3 of the application. However, the Examiner is misreading this portion of the specification, particularly in view of the remainder of the application. The sentence bridging pages 3 and 4 of the application means nothing else other than that the modifier of the present

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invention can be selected from a group consisting of a hydrophilic polymer and inorganic fine particles.

For example, beginning at page 6, second full paragraph, a "first embodiment" of the invention is described in which the film contains a hydrophilic polymer. Thereafter, beginning with the first full paragraph on page 7 of the Application, the "second embodiment" of the present invention is described in which the modified film contains the inorganic fine particles. These two embodiments are also shown by the individual examples of the application. For example, see Examples 1 and 2 at pages 19-20 of the application, with compilation of data therefrom set forth in Table 1 at page 25 of the application. These two Examples contain the hydrophilic polymer. They do not contain the inorganic particles.

Next, beginning with Example 3 at page 27, Examples are set forth which contain the inorganic fine particles. Example 3 does not contain the hydrophilic polymer. See Table 2 at page 35. Finally, see also original claim 1 stating that the substrate film comprises "at least one member selected from the group consisting of a hydrophilic polymer... and inorganic fine particles...". In other words, both modifiers need not be present, although in one embodiment, both can be present. This present divisional application is directed to the embodiment in which only inorganic fine particles are present.

In view of all of the above, Applicants must respectfully submit that the Examiner has misunderstood the present application and the position set forth in paragraph 2 of the Office Action is not only inconsistent with the present application, it is also inconsistent with the entire prosecution of the parent application.

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Accordingly, reconsideration and withdrawal of the rejection of paragraph 2 of the Office Action are respectfully requested.

In paragraph 4 on page 3 of the Office Action, the Examiner rejects claims 1, 2, and 4-7 under 35 U.S.C. § 101 as claiming the same invention as claims 4-7 of the parent patent U.S. 6,372,339.

The Examiner submits that the "comprising" terminology in claim 1 of the present application causes that claim to be anticipated by claim 4 of the parent patent. Assuming the Examiner is correct, that is not the proper test for a double patenting rejection under 35 U.S.C. § 101. For basis for a double patenting rejection under 35 U.S.C. § 101, the claims of the respective patent and application must be claiming identical subject matter. Whether claim 1 of the present application is generic to claim 4 of the parent patent is not an issue in a 35 U.S.C. § 101 rejection. For example, the "comprising" language of claim 1 of the present application would allow for inclusion of many other substances, one of which could be inorganic particles. However, the claim is much broader than claim 4 of the parent patent and thus does not claim identical subject matter. Accordingly, the 35 U.S.C. § 101 rejection is improper and should be withdrawn.

In paragraph 6 on page 4 of the Office Action, claims 3, 8, 9, 17 and 18 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 3, 4, 10, 11, 18 and 19 of the parent '339 patent. With respect to this rejection, Applicants note the final paragraph of paragraph 4 of the Office Action, wherein the Examiner states that claims 1, 2, and

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4-7 are not commensurate in scope with the previously restricted original claims 4-7 of the parent U.S. application, therefore submitting that double patenting rejection is appropriate.

Although Applicants realize that a Terminal Disclaimer can be filed to obviate this rejection, it is submitted such a Terminal Disclaimer is not necessary because the present application is a proper divisional application.

The Examiner is focusing upon the wrong subject matter in urging that the present application is not a proper divisional application. As understood, the Examiner seems to be stating that the non-elected species in the parent application is set forth in claims 4-7, while present claim 1 is broader in scope and not including specific subject matter from any of claims 4-7. Applicants must strenuously submit that the Examiner is incorrect in this regard. The Examiner should carefully review the MPEP sections regarding species election requirements. In fact, the MPEP states that the species election requirement should preferably be set forth with respect to Figures or Examples of the application, although claims can be used where convenient or necessary. In other words, the species election is just what it states, a species, it is not the subject matter of a claim. Reference to claims is used as a matter of convenience with respect to a species election. With that in mind, returning to page 2 of the Office Action dated July 10, 2001, during prosecution of the parent patent, the Examiner handling that application clearly sets forth that species A is the hydrophilic polymer and is only referring to claims 4-7 as a matter of convenience. Similarly, the Examiner states that species B is the inorganic fine particles, and again, in accordance with convenience refers to claims 10-16, 19 and 20 with respect to that species. The Examiner is not saying and it is not correct to even suggest that species A includes

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more than the hydrophilic polymer, that is, it includes other specifics of the subject matter of claims 4-7 in addition to the recitation of the hydrophilic polymer.

For the above reasons, the Examiner is respectfully requested to reconsider and withdraw the obviousness-type double patenting rejection of paragraph 6 of the Office Action.

In summary, this application should now be in condition for allowance. The Examiner is entirely incorrect with respect to the allegations that the present application is not a proper divisional application and also is incorrect in alleging that the hydrophilic polymer is not a separate embodiment of an inventive nature with respect to the disclosure of the present application.

Early indication of allowance is respectfully requested. If any minor points remain prior to Notice of Allowance, the Examiner is respectfully requested to contact the undersigned at the below listed phone number.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

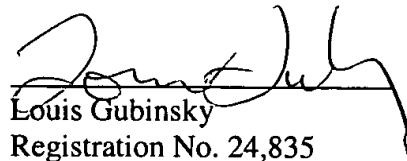
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WASHINGTON OFFICE

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